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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,396	05/22/2001	David Clarke	79888/AEK	8013

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PATENT LEGAL STAFF
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EXAMINER

MAUPIN, CHRISTINE L

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,396

Applicant(s)

CLARKE ET AL.

Examiner

Christine L. Maupin

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FILE

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Response to Amendment

The claims have been amended as follows: claims 1-12 are withdrawn and new claims 13-24 are added.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered. There is not disclosure statement in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claim 14, 15, 16, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims the applicant refers to a group being in the ortho or para position. It is unclear with respect to which groups are in an ortho or para position.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Osborn et al., US Patent No. 4,124,396 7th November 1978. Here, Osborn et al., teaches a method for making a photographic element comprising at least one silver halide emulsion layer having associated therewith a phenolic cyan dye-forming coupler of formula (column 2 lines 9-18 and Abstract), here, X is an off coupling group encompassing either a two equivalency of a four equivalency such as hydrogen, halogen, alkoxy, aryloxy, arylazo, thioether, and heterocyclic groups such as oxazolyl, diazoly, triazolyl and terrazolyl; the group of Y which encompasses the group R₃ and may be a phenyl, substituted phenyl, alkyl or 1-20 carbon atoms or a substituted alkyl of 1-20 carbon atoms, preferably alkyl, haloalkyl, phenyl, halophenyl, alkylphenyl, alkoxyphenyl and alkyaminosulfophenyl (column 2, lines 21-48); the group Z which encompasses Osborn's group R₂ and R₁ may be R₁= R₄SO₂NH- or R₄NHSO₂ where R₄ is an alkyl of 1-20 carbon atoms and together R₂ and R₄ contain a total of 8-32 carbon atoms (column 2, lines 18-48) and R₂= hydrogen or alkyl of 1-20 carbon atoms, preferably a dodecyl group; the groups R, R₁ and R₂ may independent of each other(see Table I).
3. In regards to claim 14, here, Osborn et al., teaches a method for forming a cyan dye comprising a image widely exposed silver halide emulsion layer coated on a support with an aromatic primary amine (see Table I, column 14, lines 9-14). Here, Osborn et al., teaches a method for making a photographic element comprising at least

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one silver halide emulsion layer having associated therewith a phenolic cyan dye-forming coupler of formula (column 2 lines 9-18 and Abstract), here, X is an off coupling group encompassing either a two equivalency of a four equivalency such as hydrogen, halogen, alkoxy, aryloxy, arylazo, thioether, and heterocyclic groups such as oxazolyl, diazolyl, triazolyl and terrazolyl; the group of Y which encompasses the group R_3 and may be a phenyl, substituted phenyl, alkyl or 1-20 carbon atoms or a substituted alkyl of 1-20 carbon atoms, preferably alkyl, haloalkyl, phenyl, halophenyl, alkylphenyl, alkoxyphenyl and alkylaminosulfofenyl (column 2, lines 21-48); the group Z which encompasses Osborn's group R_2 and R_1 may be $R_1 = R_4SO_2NH-$ or R_4NHSO_2 where R_4 is an alkyl of 1-20 carbon atoms and together R_2 and R_4 contain a total of 8-32 carbon atoms (column 2, lines 18-48) and $R_2 =$ hydrogen or alkyl of 1-20 carbon atoms, preferably a dodecyl group; the groups R, R_1 and R_2 may independent of each other.

4. In regards to claim 15 Osborn et al., et al., teaches that R, R_2 and R_3 may be independently an unsubstituted alkyl group (See Table I,)
5. In regards to claim 16 Here, Osborn et al., teaches that R and R_2 may be and alkyl of 1-20 carbon atoms (column 14, lines 26-34).
6. In regards to claims 17 and 18, here, Osborn et al., Here, again Osborn et al., teaches that R_1 may be an alkyl group having at least 8 carbons (Table I).
7. In regards to claim 19, here, Osborn et al., teaches in (Table 1) that $n=1$ and the group $-N(R_2)SO_2R$ is in the para position with respect the $NHCOY$ group.

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8. In regards to claim 20, here, Osborn et al., teaches the coupler wherein the group Z contains the $-N(R_2)SO_2R$ substituent and the group Y is an unsubstituted or substituted aryl group (See Table 1, coupler 13 and 16).

9. In regards to claims 21 and 22, here, Osborn et al., teaches structures encompassing the structure limitation in for the cyan dyes-forming couplers (se column 11, figures, lines 1-20 and the method for making Example 1, column 9-11).

10. In regards to claims 23 and 24, here, Osborn et al., teaches a method for making cyan dye, encompassing the limitations of the instant application with the formulas as in detailed above, image having a high speed of dye forming as well as giving dye image having a great color density when developed in a color developer such as a silver halide emulsion for color photographic use, and discloses the layering of the colors, specifically yellow, green and blue (column 8, lines 28-66).

Conclusion

Claims 13-24 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine L. Maupin; whose telephone number is (703) 308-3617 and fax number is (703) 746-7641.

The examiner is normally in the office between the hours of 9:30 a.m. and 5:30 p.m., and telephone calls either in the morning or the mid-afternoon are most likely to find the examiner in the office.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1234.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the U.S.P.T.O. Fax Center located in Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 308-4242 or (703) 308-2724. Please note that the faxing of such papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

May 6, 2002

Christine L. Maupin
Examiner
Art Unit 1637


GARY BENZION, PH.D
SUPERVISORY PATENT EXAMINER
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